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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/812,010

03/30/2004

Hyun-kwon Chung

1793.1239

2787

49455 7590 08/01/2008

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EXAMINER

WENDMAGEGN, GIRUMSEW

ART UNIT

PAPER NUMBER

2621

MAIL DATE

DELIVERY MODE

08/01/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/812,010	<b>Applicant(s)</b> CHUNG ET AL.	
	<b>Examiner</b> GIRUMSEW WENDMAGEGN	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/2/08; 5/29/2008</u> .                                     | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Regarding double patenting rejection, the instant application claims information storage medium for use with recording and/or reproducing apparatus having an ENAV buffer, medium comprising ENAV buffer configuration information for use by the apparatus in allocating at least a portion of the ENAV buffer to be an updatable markup area. The copending application claims recording and/or reproducing apparatus includes ENAV buffer; and ENAV engine to allocate at least a portion of the ENAV buffer as an updatable markup area based on ENAV buffer configuration information. The copending application, "ENAV engine" is more specific than the instant application "apparatus" used to allocate portion of ENAV buffer. The more specific claims anticipate the broader (*see In re Goodman-29 USPQ2d 2010*).

Regarding 101 rejection, "information storage medium" can be anything including non-computer readable medium. The claimed information storage medium can be given a broad interpretation which can be anything includes piece of paper and carrier signal and thus it is non-statutory subject matter. Claims drawn to components involving signals encoded with functional descriptive material do not fall within any of the categories of statutory subject matter as set forth in 35 U.S.C. 101, and are therefore,

ineligible for protection. See 1300 OG 142 (November 22, 2005, Annex IV(c) in particular).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321 (d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claim1-5 and 13** are provisionally rejected on the ground of nonstatutory Obviousness-type double patenting as being unpatentable over claim1, 3-6 and 16 of copending Application No. 10811976. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim1-5 and 13 of the present application is anticipated by claim1, 3-6 and 16 of copending application respectively.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1-25 is rejected under 35 U.S.C. 101 because it claims a storage medium, which by the specification is disclosed to include carrier wave (see specification page 19 paragraph 0059). This is non-statutory subject since the signal is not being altered in any way.

If a claimed process manipulates only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the claim is not being applied to appropriate subject matter. *Schrader*, 22 F.3d at 294-95, 30 USPQ2d at 1458-59. A claimed signal is clearly not a "process" under § 101 because it is not a series of steps. The other three § 101 classes of machine, compositions of matter and manufactures "relate to structural entities and can be grouped as 'product' claims in order to contrast them with process claims." 1 D. Chisum, *Patents* § 1.02 (1994).

Claim 1-25 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite "information storage medium" which is non-statutory subject matter. The claimed "information storage medium" can be

given a broad interpretation which can be anything includes piece of paper and carrier signal therefore it is non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claim1-25** is rejected under 35 U.S.C. 102(e) as being anticipated by Tsumagari et al (Pub No US 2003/0161615).

Regarding claim1, Tsumagari et al (hereinafter Tsumagari) anticipates an information storage medium for use with a recording and/or reproducing apparatus having an ENAV buffer, the medium comprising: an ENAV file containing ENAV data (see figure2b ENAV content); and ENAV buffer configuration information for use by the apparatus in allocating at least a portion of the ENAV buffer in which the ENAV file is to be loaded to be an updateable markup area ( see paragraph 0393); wherein the updateable markup area of the ENAV buffer is an area to store at least one ENAV file that requires updating (see paragraph 0432).

Regarding claim2, Tsumagari anticipates the information storage medium of claim 1, further comprising: a plurality of ENAV files including the ENAV file, and a loading information file including the ENAV buffer configuration information and which includes a name and a location information of a predetermined one of the plurality of ENAV files to be read by the apparatus in advance of the remaining ones of the plurality of ENAV files and which is used by the apparatus to determine an order for buffering the plurality of ENAV files into the ENAV buffer (see figure30 and 31; paragraph 0064-0065 and 0067).

Regarding claim3, Tsumagari anticipates the information storage medium of claim 1, further comprising a loading information file having a memory element including the ENAV buffer configuration information, wherein the memory element is used by the apparatus to distinguish whether the ENAV file is one of an updateable ENAV file to be loaded in the updateable markup area and another type of ENAV file which is to be loaded in another area of the ENAV buffer other than the updateable markup area (see paragraph 0395).

Regarding claim4, Tsumagari anticipates the information storage medium of claim 1, further comprising a loading information file having a memory element having an attribute, wherein: the attribute of the memory element comprises as the ENAV buffer configuration information a memory name and a size of the ENAV file, and the memory name and size are used by the apparatus to distinguish whether the ENAV file

is to be loaded in the updateable markup area corresponding to the memory name and another type of ENAV file which is to be loaded in another area of the ENAV buffer other than the updateable markup area which does not correspond to the memory name (see paragraph 0397).

Regarding claim5, Tsumagari anticipates the information storage medium of claim 1, further comprising: a loading information file including the ENAV buffer configuration file, a startup file linked to the loading information file, a directory including the loading information file and the ENAV file, wherein, in order to read the ENAV buffer configuration information in the loading information file, the apparatus reads the startup file included in the directory to be linked to the loading information file (see paragraph 0397).

Regarding claim6, Tsumagari anticipates the information storage medium of claim 1, further comprising an AV file containing AV data, wherein the ENAV file is a file used by the apparatus for reproducing the AV file with the buffered ENAV file in an interactive mode (see paragraph 0165).

Regarding claim7, Tsumagari anticipates the information storage medium of claim 6, wherein the AV file is created according to a DVD-Video format, and the ENAV file includes a markup document created with a markup language and which is



interpreted by the apparatus for reproducing the AV file with the ENAV file in the interactive mode (see figure30 and 31; paragraph 0064).

Regarding claim8, Tsumagari anticipates the information storage medium of claim 6, further comprising: an AV directory including the AV file, and an ENAV directory other than the AV directory and which includes the ENAV file and a file containing the ENAV buffer configuration information (see paragraph 0061; paragraph 0381 DVD\_ENAV directory).

Regarding claim9, Tsumagari anticipates the information storage medium of claim 1, wherein the ENAV butter configuration information includes location information used by the apparatus for loading another ENAV file from another information storage medium (see paragraph 0397).

Regarding claim10, Tsumagari anticipates the information storage medium of claim 9, wherein the location information comprises a website at which the other information storage medium is accessible from the apparatus (see paragraph 0397).

Regarding claim11, Tsumagari anticipates the information storage medium of claim 3, wherein: the memory element indicates a location of another ENAV file as being on another storage medium other than the information storage medium from which the another ENAV data is to be read by the apparatus, and a location of the

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ENAV file as being on the information storage medium from which the ENAV data is to be read by the apparatus, and using the memory element, the apparatus: loads one of the ENAV files determined to be an updateable markup file to be buffered into the allocated updateable markup area of the ENAV buffer, and loads the other one of the ENAV files determined not to be an updateable markup file into another portion of the ENAV buffer other than the updateable markup area and which is not allocated for the updateable markup file (see paragraph 0395; 0397).

Regarding claim12, Tsumagari anticipates the information storage medium of claim of claim 11, wherein the another storage medium comprises a server connected to the ENAV buffer (see paragraph 0397 server).

Regarding claim13, Tsumagari anticipates an information storage medium for use with a recording and/or reproducing apparatus in an interactive mode and which includes a buffer, the medium comprising: first data to be reproduced by the apparatus with an interactive file in the interactive mode (see paragraph 0165); and allocation information used by the apparatus to allocate a portion of the buffer to be reserved for an interactive type of the interactive file prior to the interactive file being loaded( see paragraph 067 and 0395-0397).

Regarding claim14, Tsumagari anticipates the information storage medium of claim 13, further comprising identification information which is detected by the

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apparatus to determine the interactive file to be read and which is used by the apparatus to distinguish between the updateable type of the interactive file which is to be buffered in the allocated portion and another type of the interactive file to be buffered in another area of the buffer (see paragraph 0397).

Regarding claim15, Tsumagari anticipates the information storage medium of claim 13, wherein the allocation information comprises an attribute including a name of the allocated portion and a pre-selected size, and the apparatus allocates the size of the allocated area for the interactive file to be reproduced if the interactive file is associated with the name (see paragraph 0397).

Regarding claim16, Tsumagari anticipates the information storage medium of claim 13, wherein the allocation information indicates a size of the allocated portion (see paragraph 0397).

Regarding claim17, Tsumagari anticipates the information storage medium of claim 13, further comprising location information which is used by the apparatus to locate the interactive file to be reproduced, and the apparatus uses the read allocation information to detect from the located interactive file a size of the buffer to reserve as the allocated portion (see paragraph 0397).

Regarding claim18, Tsumagari anticipates the information storage medium of claim 17, wherein the size of the allocated portion is detected by the apparatus from another information storage medium referenced by the location information (see paragraph 0397).

Regarding claim19, Tsumagari anticipates the information storage medium of claim 18, wherein the another information storage medium is on a server external to the apparatus (see paragraph 0297 server).

Regarding claim20, Tsumagari anticipates the information storage medium of claim 13, further comprising order information indicating an order of a plurality of interactive files including the interactive file to be reproduced, and the apparatus buffers the interactive file in the buffer using the order (see paragraph0065 and 0067).

Regarding claim21, Tsumagari anticipates the information storage medium of claim 13, further comprising: location information of the interactive file to be reproduced and which the apparatus uses to locate and distinguish between a location on one of the information storage medium and on another storage medium other than the storage medium, and buffer information for the interactive file to be reproduced and which the apparatus uses to distinguish whether the interactive file to is be buffered in one of the allocated portion of the buffer and another portion of the buffer not allocated for the updateable interactive file (see paragraph0395 and 0397).

Regarding claim22, Tsumagari anticipates he information storage medium of claim 13, wherein: the first data includes an image, and the apparatus interprets the interactive file to display the image from the first data in a first portion of a display and to display the interactive file as an interactive display in a second portion of the display other than the first portion (see figure2c and figure3c).

Regarding claim23, Tsumagari anticipates the information storage medium of claim 22, wherein the first data includes audio data used by the apparatus to be reproduced through an audio output as the image is reproduced in the interactive mode (see paragraph 0087).

Regarding claim24, Tsumagari anticipates the information storage medium of claim 22, wherein the first data includes a video comprising the image (see paragraph 0087).

Regarding claim25, Tsumagari anticipates the information storage medium of claim 13, wherein the first data includes audio data to be reproduced through an audio output as the interactive file is reproduced (see paragraph 0087).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GIRUMSEW WENDMAGEGN whose telephone number

is (571)270-1118. The examiner can normally be reached on 7:30-5:00, M-F, all Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Girumsew Wendmagegn/  
Examiner, Art Unit 2621

/Thai Tran/

Supervisory Patent Examiner, Art Unit 2621

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